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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,204	06/16/2000	Naokazu Nagasawa	32739	1207
116	7590	12/27/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			BRINEY III, WALTER F	
			ART UNIT	PAPER NUMBER
			2646	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/595,204

Applicant(s)

NAGASAWA ET AL.

Examiner

Walter F. Briney III

Art Unit

2646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (US Patent 6,618,586) in view of Sone (US Patent 6,223,057).**

**Claim 1** is limited to *a telephone terminal device*. Inoue discloses a device and method for searching a directory memory of a portable cellular phone. See Abstract. Inoue essentially discloses a method and apparatus that allows a temporarily stored telephone number to be stored into a more permanent directory memory. With respect to the claim limitations, the temporary memory (7) corresponds to the "temporary storage memory," and the directory memory (6) corresponds to the "at least one telephone directory memory." Whatever is meant by the limitation "different from said temporary storage memory," it is submitted that the temporary memory (7) and directory memory (6) of Inoue appear to require distinct interfaces with control section (5), and thus, are different. With respect to the "plurality of telephone directories," it is clear that Inoue only discloses a single directory. This single directory is illustrated in figure 5 of Inoue. So although Inoue allows a number stored in temporary memory (7)—in accordance with steps S1 and S2 of the registration method depicted in figure 3 of Inoue—to be stored in a directory memory (6) that comprises a single directory, Inoue

fails to disclose a "plurality of telephone directories including a plurality of user selectable directories" as recited. Therefore, Inoue anticipates all limitations of the claim with the exception of "a plurality of telephone directories," and thus, fails to meet the limitations of the "wherein clause." However, these differences will be shown below to be obvious to one of ordinary skill in the art.

In particular, Sone teaches a radio apparatus having a telephone number book with adaptable storage and retrieval indexing. See Abstract. Sone also identifies problems with using a single telephone number directory that can be overcome by registering each entered telephone number with one of a plurality of distinct groups, i.e. "user-selectable directories." See column 1, line 66, through column 2, line 45. The specific method used by Sone for number registration is depicted in figures 4, 5 and 7 and described in column 6, line 55, through column 7, line 44. In an initial step, a directory is picked in accordance with step (54) of figure 5, and registration is completed in step (57). The source telephone number is one that was previously entered, either by hand or automatically during incoming call reception.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the ability to register telephone numbers into one of a plurality of directories as taught by Sone for the purpose of reducing the load on search buttons and the overall search time.

**Claim 2** is limited to a *telephone terminal device as claimed in claim 1*, as covered by Inoue in view of Sone. Figure 5 of Inoue provides an exemplary memory mapping of the directory memory (6). It is clear that both *name* and other *information*

*related to the telephone number* -- e.g. abbreviated telephone number -- are appended to the telephone number. Therefore, Inoue in view of Sone makes obvious all limitations of the claim.

**Claim 7** is limited to *a telephone terminal device as claimed in any of claims 1 to 4*. Consider claim 1, as covered by Inoue in view of Sone, as the parent claim. Sone teaches that a telephone user "manually" chooses the directory for registration in accordance with step (54) of figure 5 and the display of figure 7. See column 7, lines 21-37. Therefore, Inoue in view of Sone makes obvious all limitations of the claim.

**Claim 8** is limited to *a telephone terminal device as claimed in any of claims 1 to 4*. Consider claim 1, as covered by Inoue in view of Sone, as the parent claim. As a first matter, the terms *preliminarily* and *automatically* are not related to any respective event or stimulus in the claim, and thus, the teachings of Sone directed towards choosing a directory before an initial registration correspond to "selecting preliminarily." Furthermore, the act of storing into memory is not performed by the user, but is "automated" by a computer. Therefore, Inoue in view of Sone makes obvious all limitations of the claim.

**Claim 9** is limited to *a telephone terminal device*. Claim 9 is limited to essentially the same matter as claim 1, as covered by Inoue in view of Sone. In addition, claim 9 expands on the selecting step made after a call. Specifically, claim 9 recites that the user selects one of the plurality of directories from a list of directories automatically provided to the user on the display after ending the call. After a call is ended in step (S3) of Inoue, the telephone prompts the user to register a number in step (S6). At this

point, the method of Sone takes over, where the user then selects a directory for the temporarily stored number in accordance with the method of figure 5 and the menu of figure 7. The menu of figure 7 corresponds to the "list of directories" as recited. Therefore, Inoue in view of Sone makes obvious all limitations of the claim.

2. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Sone and further in view of Kurosawa (UK Patent Application 2,331,890).**

**Claim 3** is limited to a *telephone terminal device as claimed in claim 1*, as covered by Inoue in view of Sone. Simply, neither Inoue nor Sone discloses, teaches or suggests erasing telephone directory entries "after passage of a predetermined time." However, this difference will be shown below as an obvious difference between the claimed invention and the cited prior art.

As memory is known to be limited, there are a plurality of methods for improving the use of this limited resource. While Inoue discloses determining whether a number is already registered in a directory and providing an indication thereof, Kurosawa teaches storing numbers in a directory, time-stamping them, and deleting those that are not used frequently. In this way, frequently used numbers are easily arranged in this specialized directory without requiring any specific user input. See page 12, line 29, through page 13, line 13, and figure 4.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include an additional directory to those already described apropos the rejection of claim 1, which time stamps each telephone number stored in the temporary memory such that old numbers are erased after passage of a predetermined time as

taught by Yasuda for the purpose of maintaining a directory comprising only frequently dialed numbers for increased speed of dialing of those frequently dialed numbers.

3. **Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Sone and further in view of Yasuda et al. (US Patent 5,062,132).**

**Claim 5** is limited to a *telephone terminal device as claimed in any of claims 1 to*

4. Consider claim 1, as covered by Inoue in view of Sone, as the parent claim. Inoue simply discloses a method for adding new telephone numbers to an existing telephone number directory while avoiding overlapping numbers. There is no indication that an external directory is interfaced with the cellular phone disclosed therein. Therefore, Inoue in view of Sone makes obvious all limitations of the claim with the exception of *an interface means for connection with an external memory device external to said terminal device*.

Yasuda discloses a telephone apparatus providing for automatic transfer of stored data between handsets. See Abstract. Yasuda recognizes that while automatic dialing directories are very convenient for assisting a telephone terminal user in remembering a large number of telephone numbers, an unforeseen circumstance resulting in the need to replace the programmed terminal device forces a user to reenter each number in the same fashion the original device had to be programmed. See column 1, lines 13-45. Yasuda simply resolves this by enabling a user to transfer existing memory of a first device to a second device by way of an interface and communication channel, such as a cable, as seen in figure 2. Also see column 1, lines 49-61.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the interface (18) as taught by Yasuda for the purpose of enabling memory from a first device to be transferred to a second device such that replacement of the first device with the second device does not require the user to reprogram the second device in the same manner as the first.

**Claim 6** is limited to *a telephone terminal device as claimed in claim 5, as covered by Inoue in view of Sone and further in view of Yasuda. Since the directory memory of the first device is copied directly to the directory memory of the second device according to the method disclosed by Yasuda, see figure 3, it follows that at least one of the telephone directory memories comprises the external memory device connected with a telephone terminal device main body via the interface means.* Therefore, Inoue in view of Sone and further in view of Yasuda makes obvious all limitations of the claim.

#### ***Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter:

4. **Claim 4 is allowed.**

**Claim 4** is limited to *a telephone terminal device*, and has been rewritten in independent form, overcoming the previous objection. Thus, claim 4 is allowable over the cited prior art for at least the reasons set forth in the Non-Final Office Action filed 24 May 2005.



### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3 and 5-9, filed 26 September 2005, have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WFB  
12/16/05



**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**